



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,285	09/07/1999	DOUGLAS W. KING	5932.1	8358

28765 7590 07/22/2004

WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET, N.W.
WASHINGTON, DC 20005-3502

EXAMINER

NGUYEN, NGA B

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,285

Applicant(s)

KING, DOUGLAS W.

Examiner

Nga B. Nguyen

Art Unit

3628

[Signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9 and 11-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-9 and 11-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 14.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3628

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on April 3, 2003, which paper has been placed of record in the file.
2. Claims 1, 3-9, and 11-40 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1, 3-9, and 11-40 have been fully considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites the limitation "said first number" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3628

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-9, 11-26, 28, 31, 37, and 38 are rejected under 35

U.S.C. 102(e) as being anticipated by Talati et al (hereinafter Talati), U.S. Patent No. 5,903,878.

Regarding to claim 1, Talati discloses a method for making purchases over a computer network using an account number that identifies a consumer's account from which funds will be withdrawn to pay a purchase price and an authorization data associated with account number which, when used with account number, enable withdrawal of funds from account (column 6, lines 25-43, the confirmation of the client when used with credit card transaction enable the credit authority authorized the transaction, when the transaction is authorized, the funds is withdrawal from the client's account), method comprising the steps of:

transmitting account number over network from a consumer location to an on-line merchant location (figures 1, 3, column 5, lines 55-62; the client 50 transmits the purchase order and credit card number to the merchant 55);

forwarding account number over network from on-line merchant location to a third party contractor location (column 5, lines 62-67; the merchant 55 transmits credit card number over the Internet or a private network to the credit authority (CA) 60);

Art Unit: 3628

transmitting a query for authorization data over network from third party contractor location to consumer location (column 6, lines 25-32; the CA 60 transmits a query for a authorization data to the client 50);

transmitting authorization data over network from consumer location to third party contractor location, bypassing on-line merchant location (column 6, lines 6, lines 33-60; the client 50 transmits the authorization data directly to the CA 60); and

after account number and authorization data are received at third party contractor location, verifying the validity of account number and authorization data (column 6, lines 33-43, column 7, lines 37-44; the CA 60 verified the account number and the confirmation by the client of transaction validity).

Regarding to claim 3, Talati further discloses account number and authorization data are transmitted over network via encrypted connection (column 6, lines 9-17).

Regarding to claim 4, Talati further discloses network is the Internet (column 5, lines 62-67).

Regarding to claims 5-7, Talati further discloses checking at third party contractor location whether account has sufficient funds to cover purchase price and transmitting a signal from third party contractor location to on-line merchant location indicating whether there are sufficient funds in account to cover purchase price and whether account number and authorization data are valid (column 6, lines 35-40; the CA checks the credit limit, a confirmation by client and transmits a rejection to the merchant).

Art Unit: 3628

Regarding to claim 8, Talati further discloses transmitting a signal from on-line merchant location to consumer location indicating whether purchase has been authorized (column 6, lines 39-40; the client is notified by the merchant of the rejection).

Regarding to claim 28, Talati further discloses consumer location is a consumer computer, on-line merchant location is an on-line merchant computer, and third party contractor location is a third party contractor computer (figure 3 and column 4, lines 58-65; processor 70, 75, 61).

Claims 9, 11-16 are system claims that have similar the limitations found in claim 1, 3-8, as discussed above, therefore, are rejected by the same rationale.

Claims 17-21, 31 have similar limitations found in claims 1, 3-8, 28, as discussed above therefore, are rejected by the same rationale.

Claims 22-26 are system claims that have similar the limitations found in claims 17-21, therefore, are rejected by the same rationale.

Claims 37, 38 are written in means that are parallel the limitations found in claims 1, 17 as discussed above, therefore are rejected by the same rationale.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 3628

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 27, 29, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al (hereinafter Talati), U.S. Patent No. 5,903,878, in view of Blonder et al (hereinafter Blonder), U.S. Patent No. 5,708,422.

Regarding to claims 27, 29, 30, 32, Talati does not disclose account number is an ATM card number and authorization number is a PIN associated with ATM card number. However, Blonder discloses account number is an ATM card number and authorization number is a PIN associated with ATM card number (column 4, line 62-column 5, line 5). Blonder also discloses the transaction processing center of the credit card provider having the validation database 106 (column 12, lines 10-30) requests the cardholder to provide a secret code that matched a similar code included in the response received from the cardholder (column 10, lines 30-67). Moreover, Talati discloses the CA 60 may query the client for various items of information that only the client would known such as mother's maiden name, driver's license number, etc. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Talati's to include the ATM card in the transaction for the purpose of providing more convenient for the consumer when using the ATM card to conduct the purchase transaction because the money is withdrawn directly from the consumer's bank account. Moreover, because the CA 60 in Talati's system queries the client for various items of information that only the client would known, thus it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the PIN associated with

Art Unit: 3628

ATM card number in Talati's various items of information in case of transaction using ATM card, for the purpose of providing the overall security of electronic commerce using the ATM card.

10. Claims 33-36, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al (hereinafter Talati), U.S. Patent No. 5,903,878, in view of Blonder et al (hereinafter Blonder), U.S. Patent No. 5,708,422, and further in view of Sixtus, U.S. Patent No. 5,903,721.

Regarding to claim 33, Talati discloses a method of making purchases over the Internet comprising the steps:

transmitting a card number which used to pay a purchase price over the Internet from a consumer's computer to an on-line merchant's web site (figures 1, 3, column 5, lines 55-62; the client 50 transmits the purchase order and credit card number to the merchant 55);

forwarding the card number over the Internet from on-line merchant's web site to a verification computer (column 5, lines 62-67; the merchant 55 transmits credit card number over the Internet or a private network to the credit authority (CA) 60);

transmitting over the Internet from the verification computer to consumer's computer a request for an authorization data associated with the card number (column 6, lines 25-32; the CA 60 transmits a query for a authorization data to the client 50);

inputting the authorization data into the consumer's computer and transmitting the authorization data over the Internet from consumer's computer to

Art Unit: 3628

the verification computer (column 6, lines 6, lines 33-60; the client 50 transmits the authorization data directly to the CA 60); and

determining using the verification computer whether the card number and the authorization data are valid (column 6, lines 33-43, column 7, lines 37-44; the CA 60 verified the account number and the confirmation by the client of transaction validity); and

transmitting a message over the Internet from the verification computer to on-line merchant's web site indicating whether the card number and the authorization data are valid (column 6, lines 35-40; the CA checks the credit limit, a confirmation by client and transmits a rejection to the merchant).

Talati does not disclose account number is an ATM card number and authorization number is a PIN associated with ATM card number. However, Blonder discloses account number is an ATM card number and authorization number is a PIN associated with ATM card number (column 4, line 62-column 5, line 5). Blonder also discloses the transaction processing center of the credit card provider having the validation database 106 (column 12, lines 10-30) requests the cardholder to provide a secret code that matched a similar code included in the response received from the cardholder (column 10, lines 30-67). Moreover, Talati discloses the CA 60 may query the client for various items of information that only the client would know such as mother's maiden name, driver's license number, etc. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Talati's to include the ATM card in the transaction for the purpose of providing more convenient for the

Art Unit: 3628

consumer when using the ATM card to conduct the purchase transaction because the money is withdrawn directly from the consumer's bank account. Moreover, because the CA 60 in Talati's system queries the client for various items of information that only the client would know, thus it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the PIN associated with ATM card number in Talati's various items of information in case of transaction using ATM card, for the purpose of providing the overall security of electronic commerce using the ATM card.

Talati does not disclose consumer's computer having a web browser. However, Sixtus discloses consumer's computer having a web browser (column 6, lines 33-53). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Talati's to include a web browser in consumer's computer for the purpose of providing a mechanism for the consumer to access the Internet.

Claims 34-36 have similar limitations found in claim 33 above, therefore are rejected by the same rationale.

Regarding to claims 39, 40, Talati does not disclose the on-line merchant web site is configured to generate a session identifier that includes an electronic address for the consumer's computer and configured to forward the ATM account number with the session identifier to the verification computer. However, Sixtus discloses the on-line merchant web site is configured to generate a session identifier that includes an electronic address for the consumer's computer and configured to forward the session identifier to the verification computer (column

Art Unit: 3628

7, lines 12-17; column 10, lines 3-10, lines 52-55; the vendor computer transmits the IP address of the user to the trust server). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Talati's to include the feature above for the purpose of providing the IP address of the consumer's computer to the CA, thus the CA can send the query information to the consumer's computer in order to validate the transaction.

Conclusion

11. Claims **1, 3-9**, and **11-40** are rejected.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Souh, can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks
c/o Technology Center 3600
Washington, D.C. 20231

or faxed to:

Art Unit: 3628

(703) 872-9326, (for formal communications intended for entry)

or:

(703) 308-3961 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen



July 9, 2004